



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/061,675

02/01/2002

James G. Norman JR.

66475/31300

1732

21888 7590 05/03/2007

THOMPSON COBURN, LLP
ONE US BANK PLAZA
SUITE 3500
ST LOUIS, MO 63101

EXAMINER

LE, LINH GIANG

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

05/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/061,675

Applicant(s)

NORMAN, JAMES G.

Examiner

Michelle Linh-Giang Le

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 8, 15-18, 20-30 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-8, 12-15, 19-23 of prior U.S. Patent No. 6738754. This is a double patenting rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5 and 11-13 rejected under 35 U.S.C. 103(a) as being unpatentable over Lapsker (4,971,362) in view of Illiff (5,935,060).

5. As per claim 1, Lapsker teaches a method of using a prescription pad to facilitate providing health care information to a patient, the prescription pad having a plurality of prescription sheets (Lapsker; Abstract), the method comprising:

Performing a diagnostic procedure on a patient to identify an ailment of the patient (Lapsker; Col. 1; lines 12-20); Examiner respectfully submits that one of ordinary skill in the art would understand a physician to examine a patient before writing a prescription.

Giving the one prescription sheet to the patient (Lapsker; Col. 1, lines 12-20)..

Lapsker teaches a preprinted prescription form with various information to help dispense a pharmaceutical product (Lapsker; Col. 4, lines 56-50). Lapsker does not expressly teach placing on at least one of the prescription sheets of the prescription pad an address for an Internet web site, information about the ailment being accessible via the Internet web site. However this is well known in the art as evidenced by Illiff. In particular Illiff does teach using the Internet as a connection for a diagnostic system (Illiff;

Col. 4, line 3). It would have been obvious to add the Internet feature of Iliff to the prescription pad taught by Lapsker with the motivation of personalizing the prescription form for use by a physician (Lapsker; Col. 4, lines 30-34) and provide an automated way of providing a patient medical advice and diagnosis that is quick, efficient, and accurate (Iliff; col. 1, lines 54-59).

6. As per claim 2, Lapsker teaches wherein the step of placing the address for the Internet web site on at least one of the prescription sheets precedes the step of performing the diagnostic procedure on the patient (Lapsker, lines 38-44). Examiner interprets "preprinted" to be printed prior to any examination by the physician.

7. As per claim 3, Lapsker teaches wherein the prescription pad is preprinted with a listing of a plurality of ailments (Lapsker; Col. 5, lines 8-11).

Lapsker does not expressly teach wherein the method further comprises instructing the patient to initiate a search via the Internet web site about one of the plurality of listed ailments. However, this is well known in the art as evidenced by Iliff. In particular Iliff does teach providing a database of diseases, symptoms, treatments, and medications for medical diagnosis and advice (Iliff; Col. 3, lines 58-61). It would have been obvious to add this feature to the Lapsker method with the motivation of providing patient medical advice and diagnosis that is quick, efficient and accurate (Iliff; col. 1, lines 54-59).

8. As per claim 4, Lapsker teaches wherein the prescription pad is preprinted with a listing of names of a plurality of ailments (Lapsker; Col. 5, lines 8-11).

Lapsker does not expressly teach wherein the Internet website is adapted to retrieve information about any one of the plurality of ailments upon initiation of a signal

Art Unit: 3626

associated with said any one of the plurality of ailments, and wherein the method further comprises instructing the patient to perform an action which initiates via the web site a signal associated with one of the plurality of listed ailments in a manner to retrieve information about said one of the plurality of listed ailments. However, this is well known in the art as evidenced by Iliff. The reasons for rejection from claim 3 are incorporated herein.

9. As per claim 5, Lapsker does not expressly teach wherein the step of instructing the patient to perform an action comprises instructing the patient to input into a computer communicating with the web site the name of said one of the plurality of listed ailments. However, this is well known in the art as evidenced by Iliff. It would have been obvious to add this feature to the Lapsker method with the motivation of providing patient medical advice and diagnosis that is quick, efficient and accurate (Iliff; col. 1, lines 54-59).

10. As per claim 11, Lapsker teaches furnishing prescription pads to health care providers, each of the prescription pads including a plurality of prescription sheets, the prescription sheets having placed thereon an address (Lapsker; Col. 4, lines 30-35). Lapsker does not expressly teach storing descriptive information about a plurality of ailments in a computer database nor does it teach providing a retrieval system accessible by an Internet user using the Internet, the retrieval system being adapted to retrieve the stored descriptive information for an ailment of the plurality of ailments upon the user initiating a signal corresponding to the ailment. However this is well known in the art as evidenced by Iliff. In particular Iliff does teach providing a database of diseases, symptoms, treatments, and medications for medical diagnosis and advice (Iliff; Col. 3, lines 58-61). Iliff also teaches using the Internet as a connection for a diagnostic system (Iliff; Col. 4, line 3). It would have been obvious to add these features to the Lapsker method with the motivation of providing patient medical advice and diagnosis that is quick, efficient and accurate (Iliff; col. 1, lines 54-59). Furthermore it would have been obvious to one of ordinary skill in the art to add an address of an

Internet website to the prescription pad taught by Lapsker with the motivation of personalizing the use by a physician (Lapsker; Col. 4, lines 33-34).

11. As per claim 12, Lapsker does not expressly teach wherein the descriptive information for each ailment comprises one or more of the following: physiological aspects of the ailment, pathological aspects of the ailment, information as to whether the ailment is treatable, information about expected clinical course, and potential complications. However this is well known in the art as evidenced by Iliff. In particular Iliff does teach providing a database of diseases, symptoms, treatments, and medications for medical diagnosis and advice (Iliff; Col. 3, lines 58-61). Iliff also teaches using the Internet as a connection for a diagnostic system (Iliff; Col. 4, line 3). It would have been obvious to add these features to the Lapsker method with the motivation of providing patient medical advice and diagnosis that is quick, efficient and accurate (Iliff; col. 1, lines 54-59).

12. Claim 13 repeats the limitations recited in claim 1 and the reasons for rejection are incorporated herein.

13. Claims 6-10, 14, 15-16, 20-24 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lapsker (4,971,362) in view of Iliff (5,935,060) and McIlroy (5,953,704).

14. As per claim 6, Lapsker does not expressly teach wherein the step of instructing the patient to perform an action comprises instructing the patient to input into a computer communicating with the web site an ICD or CPT code associated with said one of the plurality of listed ailments. However, these features are well known in the art

Art Unit: 3626

as evidenced by Iliff and McIlroy. In particular Iliff teaches using the Internet as a connection for a diagnostic system (Iliff; Col. 4, line 3). It would have been obvious to add the Internet feature of Iliff to the prescription pad taught by Lapsker with the motivation of providing an automated way of providing a patient medical advice and diagnosis that is quick, efficient, and accurate (Iliff; col. 1, lines 54-59). McIlroy teaches entering an ICD code to pull up various guidelines associated with a diagnosis code (McIlroy; Col. 11, lines 5-15). It would have been obvious to add this feature to Lapsker with the motivation of providing a health care management data processing system that is real-time and interactive and also allow others in the health care field to promote cost-effective health care (McIlroy; Col. 2, lines 55-61).

15. As per claim 7, Lapsker does not expressly further comprising instructing the patient to input into a computer communicating with the web site an ICD or CPT code associated with the ailment of which the patient was diagnosed as having, wherein the Internet web site and computer are configured in such a manner that the input of the ICD or CPT code results in retrieval via the Internet web site of information about the ailment. However, these features are well known in the art as evidenced by Iliff and McIlroy. In particular Iliff teaches using the Internet as a connection for a diagnostic system (Iliff; Col. 4, line 3). It would have been obvious to add the Internet feature of Iliff to the prescription pad taught by Lapsker with the motivation of providing an automated way of providing a patient medical advice and diagnosis that is quick, efficient, and accurate (Iliff; col. 1, lines 54-59). McIlroy teaches entering an ICD code to pull up various guidelines associated with a diagnosis code (McIlroy; Col. 11, lines 5-15). It would have been obvious to add this feature to Lapsker with the motivation of providing a health care management data processing system that is real-time and interactive and also allow others in the health care field to promote cost-effective health care (McIlroy; Col. 2, lines 55-61).

16. Claims 8 and 9 repeat the limitations recited in claim 1 and 6 and the reasons for rejection are incorporated herein.

17. Claim 10 repeats the limitations of claim 2 and the reasons for rejection are incorporated herein.

18. As per claim 14, Lapsker does not expressly teach wherein the descriptive information about each of the plurality of ailments is associated with at least one ICD or CPT code for said each of the plurality of ailments, wherein the retrieval system is adapted to retrieve the stored descriptive information for an ailment of the plurality of ailments upon the user initiating a signal corresponding to the at least one ICD or CPT code for the ailment. However these features are well known in the art as evidenced by McIlroy. In particular, McIlroy teaches entering an ICD code to pull up various guidelines associated with a diagnosis code (McIlroy; Col. 11, lines 5-15). It would have been obvious to add this feature to Lapsker with the motivation of providing a health care management data processing system that is real-time and interactive and also allow others in the health care field to promote cost-effective health care (McIlroy; Col. 2, lines 55-61).

Lapsker also does not expressly teach directing the health care providers to write on the prescription sheets the ICD or CPT codes associated with the diagnosed ailments. However this is well known in the art as evidenced by McIlroy. Lapsker does the preprinted prescription containing information required to dispense the pharmaceutical product (Lapsker; Col. 4, lines 46-50). McIlroy teaches entering an ICD code to pull up various guidelines associated with a diagnosis code (McIlroy; Col. 11, lines 5-15). It would have been obvious to add this feature to Lapsker with the motivation of providing a health care management data processing system that is real-

Art Unit: 3626

time and interactive and also allow others in the health care field to promote cost-effective health care (McIlroy; Col. 2, lines 55-61).

19. Claim 15 repeats the limitations of claim 6 and the reasons for rejection are incorporated herein.

20. Claim 16 repeats the limitations of claim 12 and the reasons for rejection are incorporated herein.

21. Claim 19 repeats the limitations of claims 1 and 6 and the reasons for rejection are incorporated herein.

22. Claims 20-24 repeat the limitations of claims 6 and 7 and the reasons for rejection are incorporated herein.

23. Claims 17-18, and 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Illiff (5,935,060) in view of McIlroy (5,953,704).

24. As per claim 17, Illiff teaches an Internet navigational system for providing health care information to a user comprising (Illiff; Abstract):

a retrieval system accessible by an Internet user using the Internet, the retrieval system being adapted to retrieve the stored descriptive information corresponding to one of the ailments upon the user initiating a signal (Illiff; Col. 3, lines 58-61 and Col. 4,

Art Unit: 3626

line3).

Iliff does not expressly teach: a computer database having stored therein descriptive information about a plurality of ailments, each ailment being associated with at least one ICD or CPT code; and the signal corresponding to the at least one ICD or CPT code associated with such ailment.

However these features are well known in the art as evidenced by McIlroy. In particular, McIlroy teaches entering an ICD code to pull up various guidelines associated with a diagnosis code (McIlroy; Col. 11, lines 5-15). It would have been obvious to add this feature to Lapsker with the motivation of providing a health care management data processing system that is real-time and interactive and also allow others in the health care field to promote cost-effective health care (McIlroy; Col. 2, lines 55-61).

25. As per claim 18, Iliff teaches wherein the descriptive information stored in the computer database comprises one or more of the following: physiological aspects of the ailment, pathological aspects of the ailment, information as to whether the ailment is treatable, information about expected clinical course, and potential complications (Iliff; Col. 3, lines 58-61).

26. Claims 25 and 26 repeats the limitations of claim 17 and the reasons for rejection are incorporated herein.

27. Claims 27 and 28 repeat the limitations of claim 17 and the reasons for rejection are incorporated herein.

Art Unit: 3626

28. Claims 29 and 30 repeat the limitations of claims 17 and 18 and the reasons for rejection are incorporated herein.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Linh-Giang Le whose telephone number is 571-272-8207. The examiner can normally be reached on 8 AM - 5PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-3600. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



LLe



C. LUKE GILLIGAN
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600